

Remarks

By this Amendment, claims 1, 11, 18, 20, 25, 29, 30, and 36 are amended and all other pending claims are unchanged. After entry of this Amendment, claims 1-39 and 52 are pending. Applicants request reconsideration in view of the amendments and the following remarks.

I. Rejection of Claims 1-39 and 52

Claims 1-39 and 52 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or alternately, under 35 U.S.C. § 103(a) as allegedly being obvious from Japanese Patent No. 2001-191314 to Yoshiyuki (Yoshiyuki). Applicants traverse this rejection and request that it be withdrawn.

Claims 1-10:

Claim 10, as amended, recites an apparatus for molding and forming at least one roughened surface texture on an uncured masonry block. The apparatus comprises a mold comprising a plurality of walls defining at least one mold cavity and a first opening through which block-forming material is introduced into the mold cavity. The mold also defines a second opening through which a formed, uncured block may be removed from the mold cavity, the mold cavity having a cross-section that is substantially constant from the first opening to the second opening. At least one said wall includes a major surface having a plurality of tapered projections extending into the mold cavity so as to contact an adjacent surface of the uncured block in the mold cavity, whereby when the uncured block is removed from the mold cavity, the projections texture the adjacent surface of the uncured block. (added language is underlined). Yoshiyuki neither teaches nor suggests the instantly claimed apparatus.

Using a mold cavity with a substantially constant cross-section provides a significant advantage in that the mold can produce a block that has a substantially constant cross-section from the bottom to the top of the block. That is, the block depth (measured front to back) and the block width (measured side to side) at the bottom of the block will be substantially the same as the block depth and block width at the top of the block.

Unlike the claimed apparatus, the mold walls 230 of Yoshiyuki are tapered at the bottom to form a gap between the block and the mold walls (see FIG. 5b of Yoshiyuki). This facilitates removal of the block from the mold by minimizing contact between the mold walls and the block

as it is removed from the mold. See paragraph 14 of Yoshiyuki. As a result, the block would have a transverse cross-sectional profile that tapers from the bottom to the top of the block.

The Federal Circuit has held that there is no suggestion to combine or modify a prior art reference if the reference teaches away from making the specific combination of elements recited in a claim. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q. 2d 1294, 1298 (Fed. Cir. 1999). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be . . . led in a direction divergent from the path that was taken by the Applicant . . .” *Id.* In the present case, Yoshiyuki clearly teaches away from a mold cavity having a substantially constant cross-section because this would eliminate the gap at the bottom of the mold to facilitate extraction of the block. Because Yoshiyuki teaches away from the device of claim 1, there is no teaching or suggestion to modify Yoshiyuki to derive the claimed device.

Accordingly, claim 1 is not anticipated or rendered obvious by Yoshiyuki and is allowable.

Claims 2-10 depend from claim 1 and are allowable for the reasons given above in support of claim 1 and because each dependent claim sets forth an independently patentable combination of features.

Claims 11-19:

Claim 11, which has been amended to include the subject matter previously recited in claim 18, recites an apparatus for molding and forming at least one roughened surface texture on an uncured masonry block. The apparatus comprises, *inter alia*, a mold including an interior surface defining at least one mold cavity having opposite end limits and rows of projections between the opposite end limits for contacting an uncured block in the mold. The projections are positioned side-by-side in each row, with each projection having a respective base that adjoins a base of an adjacent projection in the same row, and the rows of projections extending diagonally across the interior surface of the mold so as to define diagonally extending grooves between adjacent rows of projections, such that when the uncured block is removed from the mold cavity, the projections create a roughened texture on the surface of the uncured block. (added language underlined). Yoshiyuki neither teaches nor suggests the instantly claimed apparatus.

In Yoshiyuki, the inside surfaces of mold walls 230 are formed with multiple protrusions 232 interspersed with concave dimples 233. The main object of Yoshiyuki’s “invention” is to

mold a concave-convex pattern of protrusions and dimples on the surface of a block. See, e.g., paragraph 0009 of Yoshiyuki. The protrusions 232 are not arranged side-by-side in diagonally extending rows, with the base of protrusion adjoining the base of an adjacent projection, as recited in claim 11.

Regarding the positioning of the projections in Applicant's device, the action contends: [I]t would have been obvious to . . . rearrange the projections on the mold surface to form a desired embossing pattern on the block surfaces. It has been held that merely shifting the position of the parts without changing the operation of the mechanism will not render the claims patentable and the placement of the mechanism is an obvious matter of design choice. *In re Japikse*, 181 F.2d 1019, 86 U.S.P.Q. 70 (CCPA 1950); *In re Kuhle*, 526 F.2d 553, 188 U.S.P.Q. 7 (CCPA 1975)." Applicants disagree with this contention for the following reasons.

First, the Yoshiyuki device cannot be modified in the manner recited in claim 11 without rendering the device unsuitable for its intended purpose. MPEP § 2143.01 states that references cannot be modified or combined if the proposed modification would render the prior art device unsatisfactory for its intended purpose or would change the principle of operation of the prior art reference being modified. Yoshiyuki repeatedly states throughout the patent that an objective of the device is to provide a manufacturing process for forming a block with a concave-convex surface pattern. Arranging the protrusions 232 side-by-side in diagonally extending rows, with the base of protrusion adjoining the base of an adjacent projection, essentially would eliminate the concave dimples 233, and therefore, the mold would not be capable of forming a concave-convex pattern on the block, as required by Yoshiyuki's invention. Because the proposed modification would prevent the device from being used for its intended purpose, there is no teaching or suggestion to modify Yoshiyuki to derive the mold recited in claim 11.

Second, Applicants disagree that it would have been obvious to provide Yoshiyuki's mold with any desired pattern for casting a mirror image of the pattern in the block surface. When forming a block with Yoshiyuki's mold, the block is removed from the opening in the bottom of the mold in a direction perpendicular to the molding surface. Although the mold cavity widens at the bottom to facilitate extraction of the block, the positioning, shape, and size of the protrusions also must be such that the pattern molded in the block surface is preserved as the block is removed from the mold. Applicant's mold is specifically designed to prevent casting an embossed pattern of projections on a surface of an uncured block as it is removed from the

mold. Thus, Applicants submit that one would not want to use the arrangement of projections recited in claim 11 if it is desired to create an embossed pattern of projections on the block surface.

Third, the arrangement of the projections recited in claim 11 does, in fact, “change the operation of the device.” When the mold is used in the manner recited in the claim (removing the uncured block from the mold), the surfaces of the block contacting the projections will be formed with a roughened surface texture resembling that of a split block or natural stone. Even if the Yoshiyuki mold is used in the same manner, the mold would not produce the same roughened texture. This is because the flat, smooth surface of the mold wall 230 between the protrusions 232 and dimples 233 would contact the block surface. There is no hint or suggestion in Yoshiyuki for arranging the protrusions 232 and dimples 233 so as to produce a roughened texture across the entire block surface contacting the projections, as can be achieved by the device of claim 11. MPEP § 2144, p. 2100-134, provides that it is improper to rely solely on legal precedent as the rationale to support an obviousness rejection if the facts of the prior legal decision are dissimilar to those of the application under examination or if the applicant has demonstrated the criticality of the limitation. Since the arrangement of projections does provide a functional advantage (a “criticality”) over Yoshiyuki, the legal precedent cited in the action is inapplicable to the present case, and therefore is insufficient to establish a *prima facie* case of obviousness of claim 11.

Accordingly, for the foregoing reasons, claim 11 is not anticipated or rendered obvious by Yoshiyuki and is allowable.

Claims 12-19 depend from claim 11 and are allowable for the reasons given above in support of claim 11 and because each dependent claim sets forth an independently patentable combination of features.

Claims 20-24:

Claim 20 is directed to an apparatus for molding and forming at least one roughened surface texture on uncured masonry blocks. The apparatus comprises, *inter alia*, a mold comprising first and second mold cavities. Claim 20 has been amended to recite that “the mold has a first end defining openings for introducing block-forming material into the mold cavities and a second end defining openings for removing the blocks from the mold cavities, the first and

second mold cavities having substantially constant cross-sections from the first end to the second end of the mold.”

In view of certain similarities between claim 20 and claim 1, claim 20 is allowable over Yoshiyuki for the reasons given above in regards to claim 1.

Claims 21-24 depend from claim 20 and are allowable for the reasons given above in support of claim 20 and because each dependent claim sets forth an independently patentable combination of features.

Claims 25-28:

Claim 25 is directed to an apparatus for molding and forming at least one roughened surface texture on uncured masonry blocks. The apparatus comprises, *inter alia*, a mold comprising first and second mold cavities. Claim 25 has been amended to recite that “the mold has a first end defining openings for introducing block-forming material into the mold cavities and a second end defining openings for removing the blocks from the mold cavities, the first and second mold cavities having substantially constant cross-sections from the first end to the second end of the mold.”

In view of certain similarities between claim 25 and claim 1, claim 25 is allowable over Yoshiyuki for the reasons given above in regards to claim 1.

Claims 26-28 depend from claim 25 and are allowable for the reasons given above in support of claim 25 and because each dependent claim sets forth an independently patentable combination of features.

Claims 29, 31-35 and 52:

Claim 29 is directed to a wall for use in a mold for molding and forming at least one roughened surface texture on an uncured masonry block. The wall comprises, *inter alia*, a body having first and second major surfaces, with at least one of the first and second major surfaces having a plurality of projections extending outwardly therefrom. Claim 29 has been amended to further specify that “the body [has] upper and lower ends and a thickness between the first and second major surfaces that is substantially constant from the lower end to the upper end.”

In contrast, the mold wall 230 in Yoshiyuki tapers from the upper end to the lower end of the wall (see FIGS. 4 and 5). This allows the formation of a gap between the block and the mold walls to facilitate the removal of the block from the mold. See, e.g., paragraph 14 of Yoshiyuki. Yoshiyuki clearly teaches away from a mold wall having a substantially constant thickness

between the upper and lower ends of the wall because this would eliminate the gap at the bottom of the mold for facilitating extraction of the block. Because Yoshiyuki teaches away from the device of claim 29, there is no teaching or suggestion to modify Yoshiyuki to derive the claimed device.

Accordingly, claim 29 is not anticipated or rendered obvious by Yoshiyuki and is allowable.

Claims 31-35 and 52 depend from claim 29 and are allowable for the reasons given above in support of claim 29 and because each dependent claim sets forth an independently patentable combination of features.

Claim 30:

Claim 30 is directed to a wall for use in a mold for molding and forming at least one roughened surface texture on an uncured masonry block. The wall comprises, *inter alia*, a body having first and second major surfaces, with at least one of the first and second major surfaces having a plurality of projections extending outwardly therefrom. Claim 30 has been amended to further specify that “the body [has] upper and lower ends and a thickness between the first and second major surfaces that is substantially constant from the lower end to the upper end.”

In view of certain similarities between claim 30 and claim 29, claim 30 is allowable over Yoshiyuki for the reasons given above in regards to claim 29.

Claims 36-39:

Claim 36 is directed to a wall for use in a mold for molding and forming a roughened surface texture on an uncured masonry block. The wall comprises, *inter alia*, a body having first and second major surfaces, with a plurality of projections extending outwardly from the first and second major surfaces. Claim 36 has been amended to further specify that “the body [has] upper and lower ends and a thickness between the first and second major surfaces that is substantially constant from the lower end to the upper end.”

In view of certain similarities between claim 36 and claim 29, claim 36 is allowable over Yoshiyuki for the reasons given above in regards to claim 29.

Claims 37-39 depend from claim 36 and are allowable for the reasons given above in support of claim 36 and because each dependent claim sets forth an independently patentable combination of features.

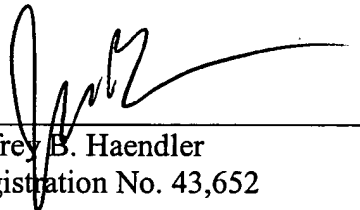
II. Conclusion

The present application is in condition for allowance and such action is respectfully requested. If any further issues remain concerning this application, the Examiner is invited to call the undersigned to discuss such matters.

Respectfully submitted,

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